

Remarks

Further and favorable reconsideration is respectfully requested in view of the foregoing amendments and following remarks.

Pending Claims

As correctly indicated by the Examiner on the Office Action Summary page, the claims pending in the application are claims 1, 3, 9, 10, 14, 19-21 and 23-32. The Examiner indicates that claims 30 and 32 are withdrawn from further consideration, and then indicates that certain claims are rejected and that other claims are objected to, none of which includes claims 29 and 31. Considering that claims 29 and 31 have been rejected under 35 U.S.C. §112 (page 8 of the Office Action), it is apparent that these claims should have been included in item 6 on the Office Action Summary page.

Examiner Improperly Withdraws Portions Of Claims

In the second paragraph on page 2 of the Office Action, after defining the elected invention, the Examiner states that the “unelected portions of claims 1, 3, 9, 10, 14, 19-21, 23-29, 31 are withdrawn from consideration.” This apparently has reference to the compounds where R² is a quinoline acid residue having a substituent, or a pyrimidine carboxylic acid residue having a substituent. However, Applicants respectfully submit that it is improper to withdraw “portions” of any particular individual claim. In this regard, please see MPEP 803.02, concerning Markush-type claims. [R² in the claims in effect sets forth a Markush group.] As apparent from this section of the Manual,

. . . the Markush-type claim will be examined fully with respect to the elected species and further to the extent necessary to determine patentability. If the Markush-type claim is not allowable over the prior art, examination will be limited to the Markush-type claim and claims to the elected species, with claims drawn to species patentably distinct from the elected species held withdrawn from further consideration.

Thus, the claims must be fully examined to the extent necessary to determine patentability over the prior art. The Examiner has not made any prior art rejection. Accordingly, it is improper to withdraw “unelected portions” of the claims.

Amendments/Rejections

The Examiner rejects claim 32 under the first paragraph of 35 U.S.C. §112. However, this claim has been withdrawn from further consideration by the Examiner. Therefore, it is not considered necessary to respond to this rejection.

The claims have been amended in response to the rejections under the second paragraph of 35 U.S.C. §112, as set forth on pages 5-8 of the Office Action. To the extent these rejections are maintained, they are respectfully traversed.

The amendments to the claims render moot the grounds of rejection in items A-M on pages 5-8. With particular regard to the amendment of claim 19, please see the disclosures at page 2, lines 7-16 and page 12, lines 34-35 of the specification, which support the amendments to this claim.

With regard to the ground of rejection in item N, claim 29 has been amended, on the basis of page 27, lines 10-14, rendering moot the rejection of this claim. With regard to claim 31, Applicants note that it does recite the “host”, i.e. “industrial products”.

In connection with the ground of rejection in item O, wherein the Examiner takes the position that “industrial products” is ambiguous, please see the disclosure at page 27, lines 15-32 of the specification, which sets forth a description of the industrial products. In consideration of this description, Applicants take the position that one of ordinary skill in the art would be able to determine the subject matter on which “industrial products” in claim 31 reads.

In connection with the rejection of claims 29 and 31 in the last paragraph on page 8, claim 29 has been amended to recite the step of “applying”, thus rendering moot the rejection of this claim. Claim 31 already recites the step of “applying”. Thus, both claims 29 and 31 direct the art-skilled to apply an effective amount of the compound or salt to the recited substrates.

Therefore, in view of the foregoing amendments and remarks, it is submitted that each of the grounds of objection and rejection set forth by the Examiner has been overcome, and that the application is in condition for allowance. Such allowance is solicited.

Respectfully submitted,

Osamu SAKANAKA et al.

By: 

Michael R. Davis

Registration No. 25,134

Attorney for Applicants

MRD/pth
Washington, D.C. 20006-1021
Telephone (202) 721-8200
Facsimile (202) 721-8250
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